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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/677,172	10/02/2003	Serkan Savasoglu	030586	8324
26285 7590 04/15/2008 KIRKPATRICK & LOCKHART PRESTON GATES ELLIS LLP 535 SMITHFIELD STREET PITTSBURGH, PA 15222				
EXAMINER				
SHAIKH, MOHAMMAD Z				
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3696				
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04/15/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/677,172

Applicant(s)

SAVASOGLU ET AL.

Examiner

MOHAMMAD Z. SHAIKH

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 1/16/08.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This Office Action is in response to and AMENDMENT entered on 1/16/08 for patent application 10,677,172.
2. This action is made **Non-Final** because examiner is making a new ground of rejections not necessitated by Applicant's amendment.

Status of Claims

3. Claims 13-24, 26-40 are pending in this application.
4. Claims 1-12, 25 have been cancelled.
5. Claims 13&14 have been amended without prejudice or disclaimer.

Claim Rejections- 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 13-19, 21-24, 27-31, 36-38, 40 are being rejected under 35 U.S.C 102(e) as being anticipated by US 2004/0133494 to Jones et al.

Regarding claim 13, Jones discloses a method comprising the steps of." issuing a unit to a holder, the unit comprising a forward contract and a remarketable security that secures performance of obligations of the forward contract, the forward contract requiring the holder to purchase of a quantity of stock from an issuer at a

settlement price on or before a settlement date, the remarketable security having an issue denomination and a maturity date later than the settlement date; and offering, at a remarketing time, the remarketable security to one or more new investors at a remarketing denomination different from the issue denomination, wherein the unit provides the remarketing denomination at time of issue ([0004], [0005], [0006], [0026]).

Regarding claim 14, Jones discloses the method of claim 13, wherein at the remarketing time, the remarketing security does not have subordination to senior debt of the issuer ([0043]).

Regarding claim 15, Jones discloses the method of claim 13, further comprising the step of: changing the maturity date of the remarketable security on the remarketing date ([0020]).

Regarding claim 16, Jones discloses the method of claim 13, further comprising the step of: adding one or more financial covenants on the remarketing date ([0026], [0027]).

Regarding claim 17, Jones discloses the method of claim 13, further comprising the step of: making the remarketable security callable after the remarketing date ([0051]).

Regarding claim 18, Jones discloses the method of claim 13, further comprising the steps of: selling the remarketable security to a new investor; and satisfying the forward contract with proceeds obtained from the new investor ([0017], [0026], [0027]).

Regarding claim 19, Jones discloses the method of claim 13, further comprising the steps of delivering a quantity of stock to the holder ([0017]).

Regarding claim 21, Jones discloses the method of claim 13, further comprising the step of collecting a remarketing fee ([0050], [0051], [0052], [0053]).

Regarding claim 22, Jones discloses the method of claim 13, wherein the remarketing security comprises a debt security ([0026]).

Regarding claim 23, Jones discloses the method of claim 13, wherein the remarketing security comprises a preferred security (claim 2).

Regarding claim 24, Jones discloses the method of claim 13, wherein the remarketing time comprises one or more remarketing dates ([0025]).

Regarding claim 27, Jones discloses the method of claim 13, wherein at the remarketing time, the remarketable security does not have a previously available interest rate deferral option to the issuer ([0026], [0027]).

Claim 28 is being rejected using the same rationale as claim 14.

Claim 29 is being rejected using the same rationale as claim 14.

Claim 30 is being rejected using the same rationale as claim 27.

Claim 31 is being rejected using the same rationale as claim 14.

Regarding claim 36, Jones discloses issuing a unit to a holder, the unit comprising a forward contract and a remarketable security that secures performance of obligations of the forward contract, the forward contract requiring the holder to purchase of a quantity of stock from an issuer at a settlement price on or before a settlement date, the remarketable security having an issue denomination and a maturity date later than the settlement date; and offering, at a remarketing time, the remarketable security to

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one or more new investors without a previously available interest rate deferral option to the issuer ([0004], [0005], [0006], [0026],[0027]).

Claim 37 is being rejected using the same rationale as claim 14.

Claim 38 is being rejected using the same rationale as claim 13.

Claim 40 is being rejected using the same rationale as claim 36.

Claim Rejections- 35 U.S.C § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. Claim 20 is being rejected under 35 U.S.C 103(a) as being unpatentable over Jones in view of , *The Journal of Finance* article, herein referred to as *Journal of Finance*.

Regarding claim 20, Jones discloses the method of claim 19. However Jones does not disclose wherein the quantity of stock is determined by a formula based on the price of the stock at expiration the forward contract payoff function. *Journal of Finance* discloses wherein the quantity of stock is determined by a formula based on the price of the stock at expiration the forward contract payoff function (page 224). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to

modify Jones's invention to include wherein the quantity of stock is determined by a formula based on the price of the stock at expiration the forward contract payoff function. One of ordinary skill in the art would have been motivated to include wherein the quantity of stock is determined by a formula based on the price of the stock at expiration the forward contract payoff function in order to ensure that at remarketing time the interest rate is reset to a well defined formula.

10. Claims 26, 32-35, 39 are being rejected under 35 U.S.C 103(a) as being unpatentable over Jones in view of US 2003/0233313 to Bartolucci.

Regarding claim 26, Jones discloses the method of claim 13. However Jones does not disclose wherein at issue the remarketable security has an issue coupon frequency, and wherein at the remarketing time, the remarketable security has a remarketing coupon frequency different from the issue coupon frequency, wherein the unit provides the remarketing coupon frequency at the time of issue. Bartolucci discloses wherein at issue the remarketable security has an issue coupon frequency, and wherein at the remarketing time, the remarketable security has a remarketing coupon frequency different from the issue coupon frequency, wherein the unit provides the remarketing coupon frequency at the time of issue ([0018]). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Jones's invention to include wherein at issue the remarketable security has an issue coupon frequency, and wherein at the remarketing time, the remarketable security has a remarketing coupon frequency different from the issue coupon frequency, wherein the unit provides the remarketing coupon frequency at the time of issue. One of

ordinary skill in the art would have been motivated to include wherein at issue the remarketable security has an issue coupon frequency, and wherein at the remarketing time, the remarketable security has a remarketing coupon frequency different from the issue coupon frequency, wherein the unit provides the remarketing coupon frequency at the time of issue in order to ensure that the entire process of issuing a unit to a holder operates efficiently.

Regarding claim 32, Jones discloses a method comprising the steps of issuing a unit to a holder, the unit comprising a forward contract and a remarketable security that secures performance of obligations of the forward contract, the forward contract requiring the holder to purchase of a quantity of stock from an issuer at a settlement price on or before a settlement date, the remarketable security having an issue denomination and a maturity date later than the settlement date ([0004], [0005], [0006], [0026]). However, Jones does not disclose offering, at a remarketing time, the remarketable security to one or more new investors at a remarketing coupon frequency different from an issue coupon frequency, wherein the unit provides the remarketing coupon frequency at time of issue. Bartolucci discloses offering, at a remarketing time, the remarketable security to one or more new investors at a remarketing coupon frequency different from an issue coupon frequency, wherein the unit provides the remarketing coupon frequency at time of issue ([0018]). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Jones's invention to include wherein at issue the remarketable security has an issue coupon frequency, and wherein at the remarketing time, the remarketable security has a

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remarketing coupon frequency different from the issue coupon frequency, wherein the unit provides the remarketing coupon frequency at the time of issue. One of ordinary skill in the art would have been motivated to include wherein at issue the remarketable security has an issue coupon frequency, and wherein at the remarketing time, the remarketable security has a remarketing coupon frequency different from the issue coupon frequency, wherein the unit provides the remarketing coupon frequency at the time of issue in order to ensure that the entire process of issuing a unit to a holder operates efficiently.

Regarding claim 33, Jones discloses the method of claim 32. Jones further discloses wherein at the remarketing time, the remarketable security does not have subordination to senior debt of the issuer ([0043]).

Claim 34 is being rejected using the same rationale as claim 26.

Claim 35 is being rejected using the same rationale as claim 33.

Claim 39 is being rejected using the same rationale as claim 32.

Response to Remarks

11. Applicant's arguments, filed on 1/16/2008, with respect to the rejections of claims 1,3,6-9,12-13,15,18-20 and 24-25 under 35 U.S.C 102(b) and claims 2,14,16 under 35 U.S.C 103(a) have been fully considered are persuasive. Therefore the rejections have been withdrawn. However, upon further consideration, a new ground(s) of rejection have been made in view of US 2004/0133494 to Jones et al and *The Journal of Finance* and further in view of US 2003/0233313 to Bartolucci.

CONCLUSION

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MOHAMMAD Z. SHAIKH whose telephone number is (571)270-3444. The examiner can normally be reached on Monday-Friday (7:30-5); alt Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Dixon can be reached on 571-272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. Z. S./
Examiner, Art Unit 3696
4/12/2008

Mohammad Z Shaikh
Examiner
Art Unit 3696

/Daniel S Felten/
Primary Examiner, Art Unit 3696